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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208873
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HERB PHARM, LLC,

Opposer,

v.

SUNFLOWER MEADOWS HERB
FARM LLC,

Applicant.

Opposition No.: 91/208,873

In re Trademark Application No. 85/447,463

Filed: October 14, 2011

For the Mark: HERB FARM AND DESIGN

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RESPONSE TO MOTION TO DISMISS

To defeat Applicant's Fed. R. Civ. P. 12(b)(6) Motion to Dismiss, Herb Pharm, LLC ("Opposer") must show that it has alleged a likelihood of confusion between the Applicant's mark "HERB FARM (and Design)" ("Applicant's Mark") and the Opposer's marks "HERB PHARM" and "HERB PHARM and Design" ("Opposer's Marks") (Applicant's Mark and Opposer's Marks may be referred to collectively as "Marks"). Opposer's allegations of confusion must be "plausible" and supported by sufficient allegations of fact as to give Applicant notice of the legal basis for the opposition. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949 (2009); Fed. R. Civ. P. 8(a)(2); TBMP§ 503.02.

As alleged in Opposer's Notice of Opposition (Dkt. 1, "Opposition"), the Applicant's Mark and the Opposer's Marks sound alike, look alike, create the same overall commercial impression, and would be used for identical classes of goods to be sold in the same channels of trade. As set forth in the Opposition, Applicant's proposed Mark is likely to cause confusion

with Opposer's Marks under the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (the "du Pont factors"). Opposer has clearly alleged a factual basis for consumer confusion in its Opposition.

In its Motion to Dismiss (Dkt. 4, "Motion"), Applicant admits that Opposer's Marks "barely differ[]" from Applicant's Mark (Motion, at 7), but argues that any likely confusion is not "actionable" or "objectionable" as a matter of law (Id. at 4). Applicant appears to argue that Opposer's incontestable 30-year-old Marks should be denied protection under the Lanham Act because each uses a "descriptive" word (Id.), or because the word "HERB" was originally disclaimed in Opposer's application (Id. at 3), or (more likely) because Applicant agreed to disclaim exclusive use of the words "HERB FARM" in its application. (Id. at 2 and 5). Applicant appears to believe that because Applicant agreed to disclaim exclusive rights to the words "HERB FARM" in its proposed mark (Id. at 2), it must also follow that Opposer has no right to protect its incontestable established trademarks after 30 years of use. Applicant's creative challenge to Opposer's Marks is misplaced, and not properly made in a motion to dismiss on the pleadings. Because the Opposition properly states a claim for relief under the Lanham Act, Applicant's Motion to Dismiss should be denied.

BACKGROUND AND ALLEGATIONS

As alleged in the Opposition, Opposer is the owner of the marks "HERB PHARM", USPTO Registration No. 2,142,522, and "HERB PHARM and Design", USPTO Registration No. 2,612,435, both for herbal, dietary and nutritional supplements in Class 5. Opposition, ¶ 1.¹

¹ The Notice of Opposition (Dkt. 1) mistakenly stated that Herb Pharm, LLC is an Oregon limited liability company – it is a Delaware limited liability company. An Amended Notice of Opposition will be filed to correct the mistake, and to clarify that Herb Pharm, LLC and Herb Pharm, Inc. (who was the original owner of the registrations and who assigned these registrations to Herb Pharm, LLC in June 2011) are collectively referred to as "Herb Pharm" in the Notice of Opposition. No other changes will be made in the Amended Notice of Opposition, although Opposer hereby requests the opportunity to amend its Notice of Opposition to correct any substantive deficiencies should the Board grant Applicant's Motion.

Opposer's Marks have been continually in use in commerce for more than 30 years. Opposer's registrations are incontestable under Lanham Act Section 15. The term "HERB" was disclaimed in both. Opposition, ¶ 1. There is no disclaimer of the term "PHARM".

Opposer's Marks have been used for herbal, dietary, and nutritional supplements for over 30 years, long before Applicant's filing date. Opposition, ¶ 2. Through the course of this use, and substantial investments of time, money, and effort in advertising and promotion, extensive goodwill and consumer recognition have developed for Opposer's Marks. Opposition, ¶ 3.

As set forth in the Opposition, Applicant's Mark is confusingly similar to Opposer's Marks. The Marks are phonetic equivalents. The Marks contain a small image of a plant above the phonetically equivalent words, and the Marks create the same overall impression.

Opposition, ¶¶ 4-6. The goods sold under the Marks are the same or closely related, and will likely be sold in the same channels of trade. Opposition, ¶¶ 7-8.

STANDARD

A properly pleaded Notice of Opposition must include: (1) a short and plain statement of the reason(s) why the Opposer believes it would be damaged by the registration of the opposed mark, and (2) a short and plain statement of one or more grounds for opposition. TBMP § 309.03(a)(2); see also 37 CFR § 2.104(a); Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752, 753 (TTAB 1985); and Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 (TTAB 1985) (allegation of priority without direct or hypothetical pleading of likelihood of confusion is insufficient pleading of Trademark Act § 2(d), 15 U.S.C. § 1052(d)).

Likelihood of confusion is a valid basis for an opposition (15 U.S.C. § 1052(d)), and is alleged by facts relevant to the du Pont factors. In any likelihood of confusion analysis, two key

considerations are: (1) the similarities between the marks; and (2) the similarities between the goods and services. See *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). The points of comparison for a word mark are: appearance, sound, meaning, and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)).

ANALYSIS

1. The Opposition states a valid ground for opposition under the Lanham Act.

In this case, Opposer's Marks and Applicant's Mark use phonetically equivalent words: Herb Pharm and Herb Farm. The composite Marks use an image of a plant in addition to the use of these words. Applicant argues that because it has disclaimed both words in its mark, and because those disclaimed words are "merely" or "purely" descriptive of where Applicant's goods are coming from, there can be no likelihood of confusion, and Opposer has no valid reason to object to Applicant's trademark application as a matter of law. Applicant's argument misses the mark for the following reasons.

a. Disclaimed portions of trademarks must be considered in the likelihood of confusion analysis.

For purposes of determining the likelihood of confusion of a mark with a registered composite mark of which portions are disclaimed, the disclaimed matter is never ignored. *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965). An applicant cannot, by disclaiming parts of its own mark, avoid a §2(d) conflict with a previously registered mark. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993) ("[T]he filing of a disclaimer with the Patent and Trademark Office does not remove the disclaimed matter from the purview of determination of likelihood of confusion.... The marks

must be considered in the way in which they are perceived by the relevant public.”). Reasonably prudent buyers neither know nor care about disclaimers, making the disclaimer irrelevant in determining likelihood of confusion. *Industria Espanola de Perlas Imitacion, S.A. v. National Silver Co.*, 459 F.2d 582, 157 USPQ 796 (C.C.P.A. 1972); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In this case, Applicant cannot avoid a §2(d) conflict with Opposer’s long-standing and well-recognized mark, simply by disclaiming a portion of its own mark.

b. Opposer’s Marks are distinctive and well-known through exclusive use for a long period of time.

As discussed herein, although Opposer’s trademark registrations include disclaimers of the term “HERB,” Opposer’s Marks, as a whole, have acquired distinctiveness through exclusive use for an extended period of time, gaining secondary meaning. As alleged in the Opposition, “the public has come to associate the Herb Pharm Mark [including any disclaimed portion thereof] with Opposer’s products.” Opposition, ¶ 3. Opposer need not prove the strength of its trademarks, or their secondary meaning, to the Board at this stage of the proceeding, but has sufficiently alleged facts on this element sufficient to defeat Applicant’s Motion.

c. The similarity of the Marks is likely to cause consumer confusion under the sight, sound and meaning test.

Opposer has alleged a prima facie claim of potential confusion under the du Pont factors—and particularly when comparing similarities of the Marks in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361.

i. The Marks have a similar appearance.

The Marks look very similar, even though they are spelled slightly differently (the only difference is whether “ph” or “f” precedes the letters “arm”). Marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. See, e.g., *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding TMM confusingly similar to TMS); *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985) (finding NEWPORTS and NEWPORT to be essentially identical in appearance). Both Marks contain an image of a plant above the phonetically equivalent words.

ii. The Marks sound the same.

The Marks are indistinguishable from each other when spoken aloud, which is likely to cause confusion in the marketplace. Consider, for example, the following hypothetical:

A boy is asked to stop by the drugstore on his way home from school to pick up an extract for his mother. She asks him to pick up some “Herb Pharm Echinacea extract.” The boy goes to the store, and finds Herb Farm products and assumes he has found what his mom requested and buys the wrong product based on his inability to distinguish the two marks when they are spoken aloud.

Similarity in sound may be sufficient, by itself, to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007).

iii. The Marks have the same meaning and make the same commercial impression.

Applicant seeks to register the similar looking and sounding words “HERB FARM”, and the image of a plant. Applicant’s use of slightly stylized lettering does little to distinguish the Marks, as Opposer’s Marks are not limited to any particular font, size, or color. A registrant of a standard character mark is entitled to all depictions of a that mark regardless of the font style, size, or color, and not merely “reasonable manners” of depicting such mark. *In re Viterro Inc.*,

671 F.3d 1358, 1364-65, 101 USPQ2d 1905, 1910 (Fed. Cir. 2012); Citigroup Inc. v. Capital City Bank Group, Inc., 637 F.3d 1344, 1353, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011).

Applicant's Mark does not add any other words to distinguish or describe its goods from Opposer's. As such, and especially when spoken aloud, both Marks share the same meaning and commercial impression. All three factors, sight, sound, and meaning, favor a finding of likelihood of confusion.

d. The similarity of the goods and channels of trade only increase likely to cause consumer confusion between the Marks.

In any likelihood of confusion analysis, the two key considerations are the similarities between the marks, and the similarities between the goods and services. In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Applicant admits that it seeks to register Applicant's Mark for the same class and sorts of goods as sold under Opposer's Marks. It is likely that the Marks would be used on closely related goods, in the same channels of trade. This is another du Pont factor alleged to cause confusion in the Opposition which properly states a claim for relief.

2. Applicant does not propose to use the words "herb farm" in a truly descriptive sense.

In its Motion, Applicant incorrectly asserts that "the only objectionable element [in Applicant's Mark] is conceded to be a descriptive phrase used in a purely descriptive manner", a phrase that "serves to identify and describe its products to consumers." (Motion, at 1). But there is no agreement on the descriptive quality of Applicant's Mark.² Applicant asserts that its mark

² Although the Examining Attorney allowed the Application by requiring Applicant to disclaim the exclusive right to use the phrase "Herb Farm" (Motion, at 2), the Examining Attorney did not opine that the Opposer's 30-year-old mark, which has been registered for the last 10 years, is purely descriptive, and thus is only entitled to limited protection from junior users adopting aurally identical, confusingly similar marks. Indeed, Opposer was not requested to disclaim "PHARM" in either of its registrations. Applicant's disclaimer of these terms should not be

is “purely descriptive” of its products. It is not. Applicant’s product is not an herb farm. The words “herb farm” do not describe the goods in the Application, and Applicant is not proposing to use the Mark in a “purely descriptive manner.” Rather, both parties are in the business of selling dietary supplements and other products that are often, but not always, extracted from herbs grown on a farm.

Although Applicant attempts to justify its use as “descriptive” or “fair”, and cites *KP Permanent Make-Up Inc. v. Lasting Impression Inc.*, 543 U.S. 111, 121-22 (2004) for the proposition that trademark law should not be stretched to deprive commercial speakers of the “ordinary utility of descriptive words,” (Motion, at 4), Applicant’s use goes beyond classic fair use, and its reliance on *KP Permanent Make-Up* is misplaced. That case involved a “fair use” defense to an action for infringement brought by a trademark owner. It was not about a new application for a nearly identical registered trademark, for use in the same class of goods and in the same channels of trade.

In this case, Applicant does not propose to make fair use of the words “herb farm” in a sentence. Nor does Applicant use the words to describe “Sunflower Meadows Herb Farm”, or to describe herb farms in general, or even to describe Opposer’s products. Applicant has not even begun to “use” the mark, let alone use it fairly. In this case, Applicant filed an intent-to-use application seeking to register a trademark so similar to Opposer’s Marks, that it is likely to cause confusion in the marketplace.

Applicant proposes to use the words “HERB FARM” as a trademark for nearly identical goods, not as a description of a farm, and seeks to excuse its infringement on Opposer’s Marks

used as self-serving evidence that the words should be disregarded in a likelihood of confusion analysis merely because they may be used to describe a farm that grows herbs. This determination should be made by the Board, later in this proceeding, after allowing discovery and hearing arguments from both parties.

by baldly and inexplicably asserting that “a consumer will immediately understand that ‘Herb Farm’ describes the Applicant’s products, and that such use is laudatory and descriptive.” (Motion, at 5). It is not so. Unlike *In re The Place Inc.*, 76 USPQ2d 1467, 1468 (T.T.A.B. 2005) (cited in the Motion, at 5), where the phrase “The Greatest Bar” was at issue, there is no “laudatory” function to Applicant’s Mark. In this case, Opposer has acquired significant rights in Opposer’s Marks through use as source identifiers on its products for more than 30 years, and in reliance on federal registrations that are now incontestable, and Applicant should be forced to select a trademark that is not confusingly similar.

Opposer is, by no means, trying to monopolize the term “herb farm” by changing its spelling (as suggested by the Applicant’s orange juice hypothetical) (Motion, at 7). Many companies use the words “herb farm” in their names and trademarks. The February 2, 2012 Office Action cites to numerous other uses of the words “herb farm” along with other source identifying words or images that are not confusingly similar to Opposer’s Marks. In this case, however, Applicant has not yet begun its proposed use, and should be forced to choose a mark for its goods that is not so similar to Opposer’s Marks that it is likely to confuse consumers, and one that does not trade on the strength of the goodwill built up by Opposer’s business through the long-standing use of its marks.

CONCLUSION

By its Opposition, Opposer does not seek to deprive commercial speakers of the ordinary utility of the words “herb farm.” That is not what the Opposition is about. The Opposition is about preventing registration of a trademark that is so similar to Opposer’s Marks that it will likely cause confusion in the marketplace. The Opposition sufficiently alleges facts to state a claim for relief under the Lanham Act based on the similarity between the Marks, and the

confusion that is likely to ensue should Applicant's trademark application be granted. For these reasons, the Motion to Dismiss should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that I served the foregoing **RESPONSE TO MOTION TO DISMISS** on the Applicant on March 18, 2013 by mailing a true and correct copy thereof, addressed to Applicant's attorney of record at the address shown below, and deposited in the United States mail on said day with sufficient postage, in a sealed envelope, at the post office at Portland, Oregon:

John J. Scally, Jr.
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